

Remarks

I. Summary of the Interview

Applicants would like to thank Examiner Tung for the time taken to discuss the present application with Applicants' undersigned representative during a personal interview held on August 22, 2000. During this interview, the outstanding obviousness rejection over Burmer in view of Carninci, which was maintained in the final Office Action dated January 5, 2000 (Paper No. 12), was discussed. The Examiner indicated that Applicants' arguments directed to this rejection would be considered upon filing of a CPA.

II. Status of the Claims

Claims 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31, 32 and 41-43 are pending in the application, with claims 1 and 41 being the independent claims.

III. Summary of the Office Action

In the Office Action dated January 5, 2000, the Examiner has maintained one rejection of the claims. Applicants respectfully offer the following remarks to overcome this rejection.

IV. The Rejection Under 35 U.S.C. § 103(a) Is Traversed

In the Office Action at pages 2-3, the Examiner has maintained the rejection of claims 1, 2, 6, 12, 16-20, 22, 25, 28, 29, 31, 32 and 41-43 under 35 U.S.C. § 103(a) as being unpatentable over Burmer, U.S. Patent No. 5,726,022 (Doc. Ref. AH1, of record; hereinafter "Burmer") in view of Carninci *et al.*, *Genomics* 37:327-336 (1996) (Doc. Ref. AR1, of record;

hereinafter "Carninci"). Applicants respectfully traverse this rejection, and reiterate and incorporate by reference herein the remarks in traversal of this rejection that were included in Applicants' Amendment and Reply Under 37 C.F.R. § 1.111 filed on October 12, 1999. In particular, Applicants wish to point out that, as was discussed with the Examiner in detail during the interview, the adaptors of Burmer are *not* contained on primers used for synthesis of a nucleic acid molecule. Instead, Burmer describes *ligating* double-stranded adaptors to nucleic acid fragments. Burmer therefore is seriously deficient as a primary reference upon which to base a *prima facie* case of obviousness of the presently claimed invention in which adaptors and, as discussed in detail in Applicants' reply of October 12, 1999, the deficiencies of Burmer in this regard are not cured by the disclosure of Carninci.

Thus, since Burmer and Carninci, alone or in combination, do not disclose or suggest the presently claimed invention, the ordinarily skilled artisan would not have been motivated to combine the disclosures of Burmer and Carninci to make and use the claimed invention with any reasonable expectation of success. Absent such suggestion and motivation, the cited references may not be properly combined to render the claimed invention obvious. *See In re Fine*, 5 USPQ2d 1596,1598 (Fed. Cir. 1988); *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Thus, the Examiner has not met the burden required to sustain a *prima facie* case of obviousness.

In view of the foregoing remarks, Applicants respectfully assert that a *prima facie* case of obviousness of the claimed invention cannot be established based on the disclosures of Burmer and Carninci.

V. **Conclusion**

All of the stated grounds of rejection contained in the Office Action of January 5, 2000, have been properly traversed by the foregoing remarks. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they not be maintained in any forthcoming Office Action in the CPA.

Applicants believe the present application is in condition for immediate allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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